

REMARKS

Reconsideration of the rejections set forth in the Office Action mailed June 30, 2005, is respectfully requested. Claims 46-51, 54-62, and 65-67 remain pending in this application.

Art Rejections

Claim 46-51, 56-57, 60- 62, and 67 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Campbell et al. (USP Re. 34,936) in view of Kandany (USP 5,562,613). The examiner has taken the position that “it would have been obvious to one skilled in the art at the time that the invention was made to have modified Campbell et al. ‘936 and incorporated the teaching of Kaldany ‘613 in order to alter the end of the catheter to have a closed distal end with a side exit port defining a plane, the plane being parallel to the longitudinal axis of the tube ... in order to enable the physician to advance the marker at the area of interest with greater precision once the side port has been aligned with the tissue of interest by allowing for a simple unidirectional handed motion.” Applicants respectfully assert that these references are not properly combinable. Indeed, there is no suggestion for why greater precision would be needed or why the Campbell device would not be as precise as the Kaldany device. Likewise there is no explanation for why “unidirectional handed motion” is preferred or why use of the Campbell device alone would not be considered unidirectional handed motion. In the absence of a need for greater precision or a desire for unidirectional handed motion, there would be no motivation to make the asserted combination.

Claims 46, 47, 48, 49, 50, and 60 are therefore patentably distinct from the cited art. Claims 51 and 54-58 are dependent on claim 50, and are therefore patentably distinct from the cited art for the same reasons. Claims 61-62 and 65-67 are dependent on claim 60, and are therefore patentably distinct from the cited art for the same reasons.

Patent US 224C3
Attorney Docket: 032,290-109
(formerly END-777)

For all the foregoing reasons, Applicant asserts the claims are in condition for allowance.

Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 737-2900. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,
O'MELVENY & MYERS LLP

Dated: September 30, 2005

By: Diane K. Wong
Diane K. Wong
Reg. No. 54,550
Attorneys for Applicants

JCK/DKW/cp

O'Melveny & Myers LLP
610 Newport Center Drive, Suite 1700
Newport Beach, CA 92660-6429
(949) 760-9600